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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of:	:	
Zhi et al.	:	
Serial No.: 10/590,119	:	PETITION DECISION
Filed: June 11, 2007	:	
Attorney Docket No.:	:	
33310.01112.US02/1112US		

This is in response to the petition under 37 CFR § 1.181, filed April 28, 2011, requesting that the finality of the Office action of April 15, 2011 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on November 3, 2010 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1-25, 27-35, 62-70, 72-78 and 82 were pending. The examiner rejected claims 1-25, 27-35, 62-68, 78 and 82 and withdrew claims 69-70 and 72-77 from consideration. Claims 1, 2, 3, 4, 12, 13, 14, 15, 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Selvakumar et al. Claim 5, 17 were rejected under 35 U.S.C. 102(b) as being anticipated by Rettig et al. Claim 6, 7, 8, 9, 10, 11, 22, 23, 24, 29 were rejected under 35 U.S.C. 102(b) as being anticipated by Oki et al. Claim 18,19, 20, 21,25, 27, 28, 30, 35 were rejected under 35 U.S.C. 102(b) as being anticipated by Abdallah et al. Claims 30, 31,32, 34, 35 were rejected under 35 U.S.C. 102(b) as being anticipated by Sokolov et al. Claim 62 was rejected under 35 U.S.C. 102(b) as being anticipated by Zyss et al. Claim 30 and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sokolov et al. Claim 62 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In reply to the non-final Office action of November 3, 2010, applicants filed a response on February 14, 2011. The response submitted by applicants included remarks, arguments traversing the rejections made in the non-final Office action and amendments to the claims.

On April 15, 2011, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1-25, 27-35, 62-69, 72-78 and 82-86 were pending. The examiner rejected claims 1-25, 27-35, 62-68, 78 and 82-86 and withdrew claims 69 and 72-77 from consideration. Claims 1 and 18 were rejected under 35 U.S.C. 102(b) as being anticipated by Sues et al. Claims 1-4, 8-25, 27, 30, 34, 63-68, 78, 82, 83, 85, 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. Claims 1-5, 8-25, 27, 30, 34, 63-68, 78, 82, 83, 85, 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Sunjic et al. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Elslager et al. Claims 1,22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jin et al. Claims 1-25, 27-35, 62-68, 78, 82-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In response thereto, applicants filed this petition on April 28, 2011, requesting that the finality of the Office action of April 15, 2011 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on April 28, 2011, applicants submit that the finality of the Office action of April 15, 2011 is premature. Applicants argue that "In the instant Office Action, the Examiner newly has rejected claims 1-25, 27-35, 62-68 and 78 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter because the recitation "pharmaceutically acceptable ester or amide thereof" is considered "vague and indefinite." Applicant respectfully submits that, to the extent that this ground of rejection is proper, it could have been applied to claims 1-25, 27-35, 62-68 and 78 in the previous Office Action. Claim 1 was amended in the previous Response, mailed February 14, 2011, to eliminate hydrogen and alkyl as alternatives in the definition of R^2 and to correct an error in the definition of R^9 by including the selections COR^A and $CO2R^A$, which are recited in original claim 2. Claim 1 as previously pending recites "or a pharmaceutically acceptable salt, ester, or amide thereof." Original claim 1 recites "or a pharmaceutically acceptable salt, ester, amide or prodrug thereof." Claims 2-25, 27-35, 62-68 and 78 ultimately depend from claim 1 and include every limitation thereof. Thus, to the extent this rejection is pertinent to pending claims 1-25, 27-35, 62-68 and 78, previously pending claims 1-25, 27-35, 62-68 and 78, which included the recitation "or a pharmaceutically acceptable salt, ester, or amide thereof," could have been so-rejected in the last Office Action. Therefore, the new ground of rejection is not necessitated by the amendment of claim 1 in the previous Response." Similar reasoning applies to claims 30-35.

Applicants' argument is well taken and persuasive since applicants' amendments did not necessitate the new rejection. It is pointed out that the language which forms the basis for the 35 USC 112, second paragraph, rejection was clearly present in the claims before the examiner at the time of the non-final Office action of November 3, 2010.

It is pointed out that MPEP § 706.07 recites:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).
>
> Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, it is decided that Applicants' argument is well-taken and found persuasive.

DECISION

The petition is **GRANTED.**

The Office action mailed April 15, 2011 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Jacqueline Stone
Director, Technology Center 1600